

Application No.: 10/664,427

Amendment and Response to Office Action dated December 21, 2005

Office Action dated August 26, 2005

Docket No.: 1421-58 DIV II

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### **REMARKS**

Claims 18-21 are currently pending. In view of the comments below, reconsideration of the present application is respectfully requested.

#### **Applicants' Response to Rejection of Claims Under 35 U.S.C. §103**

Claims 18-21 have been rejected under 35 U.S.C. §103 as allegedly unpatentable over U.S. Patent No. 5,667,824 to Ream et al. ("Ream") in view of U.S. Patent No. 4,975,288 to Hager et al ("Hager"), U.S. Patent No. 810,210 to Laws ("Laws"), U.S. Patent No. 3,062,662 to McDonald ("McDonald"), and the press release to "LMC International". Applicants respectfully traverse these rejections on the grounds that the Examiner has failed to establish a *prima facie* case of obviousness. Specifically, the references include no motivation to modify or combine the references, the teachings of the references are not properly combinable, and even if combined, the references fail to teach the invention as claimed. Therefore, reconsideration and withdrawal of the rejections are respectfully requested.

The present invention includes a method of making a three-material lollipop product which includes a candy coated, center-filled gum. The lollipop is prepared by (1) extruding a gum material, (2) transporting the extruded gum to a batch forming mechanism, (3) injecting a center-fill into the gum, (4) coating the gum material with a molten candy material, and (5) forming individual lollipop balls from said candy coated gum material in a lollipop forming mechanism.

M.P.E.P §2143 states the "Basic Requirements of a *Prima Facie* Case of Obviousness. In order to establish a *prima facie* case of obviousness, (1) a reference or combination of references must provide some suggestion or motivation to modify the reference or to combine the teachings; (2) there must be a reasonable expectation of success; and (3) there must be a teaching or suggestions of all claim limitations. The teachings must consider the reference as a whole and the proposed modification cannot render the prior art unsatisfactory for its intended purpose.

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The Examiner has alleged at page 2 of the Office Action dated August 26, 2005 that the Applicants have impermissibly attacked the references individually in an attempt to show non-obviousness. Applicants respectfully submit this is not true. Given the numerous references that are combined by the Examiner, the Applicants first point out what each of the references teaches and then point out the reasons why the combination fails to provide a *prima facie* case of obviousness under Section 103.

The combination of Ream, Hager, Laws, McDonald, and LMC International fails to establish a *prima facie* case of obviousness because (1) there is no motivation to combine the references, (2) there is no reasonable expectation of success and (3) the combination of the reference renders the prior art unsatisfactory for its intended purpose.

Important aspects of the requirements for motivation to combine and expectation of success are that both must come from the prior art and not from the disclosure of the present invention. According to MPEP §2143, "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." Applicants addressed the deficiencies of the motivation to combine with respect to each reference in the response dated July 11, 2005.

The Examiner states that the motivation to combine the references is found in the Office Action dated February 9, 2005 where it states, "It therefore would have been obvious to inject gum formed by the method of Ream with a center-fill semi-liquid material, as taught by Hager and Laws, in order to incorporate additional flavors and keep the gum in its moist and plastic condition for along time." However, this is actually contrary to the purpose of Hager. Hager seeks to provide a center-fill gum which provides the separate sensation of liquid upon chewing. Laws provides a center-fill gum with the intention that the center-fill will migrate into the surrounding gum which keeps the gum in its "moist and plastic condition" not to prevent such migration as is sought by Hager.

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Ream teaches a method of preparing a miniature confection which is preferably a gum. In Ream's method, a sheet of gum material is extruded and then cooled and formed into a "webbed sheet" by passing the gum sheet through a series of rollers. The "webbed sheet" is removed as a whole and individual gum pieces are broken off of the mat. Cooling is an essential step of the Ream method as the low temperature is required to prevent tackiness and may be achieved through a nitrogen cooling system. See Ream column 4, lines 21-24. There is no teaching or suggestion in Ream to provide a gum piece which is center-filled or includes a candy coating.

Hager provides a method of preparing a center-filled chewing gum which provides an advantage over prior methods of preparing center-filled gums in that the gum pieces may include 35-40% by weight center-fill. This is compared to prior methods which could only achieve 12-17% by weight center-fill. The center-filled gum is prepared from a filled extruded rope of gum, which is incompatible with the webbed mat forming device provided by Ream which requires a sheet of gum.

Laws teaches a method of preventing gum from becoming hard and brittle, which results in a commercially unacceptable product. Laws teaches forming hollow chewing gum tubes and filling the individual hollow gum pieces with a liquid which is absorbed into the gum piece to compensate for moisture lost as the gum dries. A moisture-resistant coating is first applied to the interior of the hollow tube to prevent the liquid center from transferring too quickly to the gum piece. Laws does not provide a center-filled gum as in the present invention. The liquid added to the center is not meant to provide a "burst" of flavor upon chewing the gum piece as in Hager. Instead, the liquid is meant to be transferred to the gum material prior to reaching the consumer in order to "keep the piece of gum in its natural moist and plastic condition." See Laws column 1, lines 23-24.

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The method of Ream is itself not compatible with the preparation of a center filled gum. Hager requires the preparation of a liquid filled rope and Laws requires the filling of a hollowed gum piece. Since Ream provides for neither the preparation of an extruded rope of gum nor a hollowed gum piece, the combination of the teachings of Ream with either Hager or Laws, the would not result in a center-filled gum piece.

To combine the teachings of Ream with either of the recited other references is improper absent some showing of motivation to combine them. In this case, not only is there no motivation, but any attempt to combine would require changes to Ream which would destroy that reference's intent and purpose. Specifically, as Ream is directed to the preparation of a miniature confection which is detached from a webbed sheet, the method is not properly combinable with a method of preparing an extruded rope, or a center-filled gum.

Considering that there is no motivation to combine Ream with Hager and Laws, a *prima facie* case of obviousness has not been established. However, the Examiner further alleges a center-filled chewing gum may then be combined with a candy coating citing McDonald which teaches a candy coated gum confection and may further be formed into a ball shape citing LMC International which teaches a ball shaped lollipop forming mechanism.

Assuming *arguendo* that the combination of Ream, Hager, and Laws does result in the formation of a center-filled gum composition, there is no teaching or motivation to modify such a chewing gum piece by adding a candy coating. McDonald does not teach or suggest, nor provide an mechanism for preparing a candy coated, center-filled chewing gum.

Although McDonald does provide a candy coated gum, McDonald specifies that the coating is applied by first placing a lollipop stick in a gum piece and then dipping the gum piece at least once into a hot (300 – 310F) candy syrup and then placed on a flat surface for cooling. The gum must stay in the syrup for a sufficient time "so that the bubble gum will partially melt and soften and mix with the candy." Column 2, lines 54-55. Further, [t]he intermixing occurs

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while the candy is a heated liquid, saturating the bubble gum material, and form[ing] hardened brittle crystals and areas in and on the bubble gum materials when cooled so that a crunchy characteristic results." Column 1, lines 36-40. The purpose of McDonald is to provide a combination of candy and gum where "the candy composition intermixes with a substantial part of the bubble gum material." Column 1, lines 35-36.

Clearly, McDonald provides no motivation to modify its disclosure. Moreover, even if the method taught by McDonald is performed with a center-fill gum, one of ordinary skill in the art would have no expectation of success. McDonald does not contemplate the inclusion of a center-filled gum and therefore does not accommodate for the potential issues of leaking of the center. Melting the gum layer and impregnating it with hard candy crystals as required by McDonald would lead to leaking of the liquid center which is contained by the gum, not to mention the likelihood of eliminating the separate gum layer, as it would be combined with the hard candy.

McDonald requires the combination of a gum with the candy by melting the gum and candy together. McDonald is concerned only with solid gum centers which are dipped into hot candy syrup. It is clear from the teachings of McDonald that this dipping process was not intended for liquid-center-filled gums since to allow partial melting and softening of the candy with the gum will jeopardize the integrity of the center-filled gum as will impregnating the gum with hard candy crystals. As the Examiner is aware, there are many difficulties in producing and maintaining commercially viable center-filled gums and one of ordinary skill in the art would avoid processes which might introduce additional problems such as premature migration. Thus one of ordinary skill in the art would not employ the process as taught by McDonald to coat a center-filled gum since using the method of McDonald would not provide one of ordinary skill in the art with a reasonable expectation of success.

Also, as discussed above, neither McDonald nor the combination of Ream, Hager, and Laws provides a teaching or suggestion to provide a hard candy layer and an separate gum layer.

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The only teaching of a hard candy in combination with a gum layer is found in McDonald, wherein there are not two layers, but to the contrary, the gum and hard candy are mixed.

As stated in the Response dated July 11, 2005, Applicants respectfully renew their assertion that the combination of McDonald and LMC International do not provide a candy coated gum that may be shaped into a ball. The Examiner asserts at page 3 of the Office Action dated August 26, 2005 that it is "notoriously well known to shape lollipops into balls, as evidence by LMC International. As such, it would have been an obvious matter of choice to form the candies into conventional ball shapes instead of the bell shapes taught by McDonald. Applicants respectfully submit that this is not a proper standard for establishing a *prima facie* case of obviousness.

Applicants acknowledge that LMC International teaches a mechanism for the formation of lollipop balls. However, LMC International does not provide any motivation to modify its teachings to prepare a candy-coated gum into a lollipop ball. The disclosure of LMC International is limited to lollipops. One following the teachings of LMC International would have no reasonable expectation of success of preparing a candy-coated lollipop ball considering that LMC International provides no teaching or suggestion that the device is compatible with a gum material.

With respect to McDonald, not only is there no teaching to provide the lollipop confection in a ball shape, McDonald teaches away from any other than the "bell-shaped" confection that results from the drying on the flat surface. McDonald requires the flat edge which is "a particularly desirably shape for the confections as it enables the same to be advantageously displayed for sale." Column 2, lines 46-48. To modify the teachings of McDonald to prepare a ball-shaped confection is contrary to the intent and purpose of McDonald. Since the proposed modification would render the McDonald unsatisfactory for its intended purpose, the combination of McDonald and LMC International is insufficient to establish a proper *prima facie* case of obviousness.

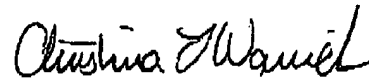
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For the reasons set forth above, there is no motivation in any of the references to combine the teachings of each. Even if combined, the references would not lead one of ordinary skill in the art to prepare the invention of the present claims.

In view of the above amendments and remarks, Applicants respectfully submit that the present application, including claims 18-21 is now in condition for allowance. Favorable action thereon is respectfully requested.

Should the Examiner have any questions with respect to the above amendments and remarks, the Examiner is respectfully requested to contact Applicants' undersigned counsel at the telephone number below.

Respectfully submitted,



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